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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/854,166

05/11/2001

Paul R. Goldberg

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10/20/2006

PARSONS HSUE & DE RUNTZ LLP  
595 MARKET STREET  
SUITE 1900  
SAN FRANCISCO, CA 94105

EXAMINER

KNEPPER, DAVID D

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/854,166	GOLDBERG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David D. Knepper	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-14,16-19,21-24 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-14,16-19,21-24 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 sheet: 3, 21, 22 / 8; 3, 26</u> | 6) <input type="checkbox"/> Other: _____  |

1. Applicant's correspondence filed on 3 Aug 2006 (IDS and Amendment) has been received and considered. Claims 1, 3-14, 16-19, 21-24 and 27 are pending. Claims 2, 15, 20, 25, 26 and 28-51 are canceled.
2. This application was abandoned following a requirement for Restriction mailed 13 Dec 2004. This application was revived following a Petition filed 8 November 2005 which was granted on 1 Dec 2005.
3. The Petition included an election of group I. Claims 1-27, stating the applicant's belief that claim 27 was erroneously placed in group II. This argument is correct.

#### **Information Disclosure Statement (IDS)**

4. The International Search report does not qualify as prior art because it is not, of itself, a published document (it is not even clear when this document was published since the date provided is when the search was complete). However, it does qualify as a statement of relevance (37 CFR 1.98(3)(i)) if the relationship between the claims of the instant application and the PCT application searched is identified. However, if it was published as part of an examined PCT application, then why did the applicant fail to provide the document under which it was published?

The applicant's IDS was considered. As noted above, the European Patent Office search report is considered a statement of relevancy as opposed to a published prior art reverence.

#### **Title**

5. The title of the invention is objected to because of the inclusion of “and other types of signals”. While the specification suggests that it is possible to add noise to other types of signals such as video, no details for achieving such desired results are present in the application.

The terms “adding imperceptible noise” contradicts the subject matter of claim 11 which is towards “removing at least one component”.

Correction is required.

#### **Drawings**

The drawings are accepted

#### **Priority Claims**

6. The applicant(s) should check their filing receipts and/or the Patent Application Information Retrieval (PAIR) system for the acknowledgment of their **domestic** priority or benefit claims (if any) under 35 USC 119(e), 120 or 121 (37 CFR 1.78).

#### **Specification**

The disclosure is accepted.

#### **Claims**

7. The applicant’s amendments overcomes the previous rejection under 35 USC 112, first paragraph.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 3-10, 12-14, 16-19, 21-24 and 27 are rejected under 35 U.S.C. § 103 as being unpatentable over Warren (5,719,937) in view of Fukada (6,469,239).

As per claims 1, 19 and 22: “Modifying the audio signal in a manner that does not change a perception of the signal by a human ear” is taught by Warren in column 2, lines 28-31 where he teaches that his control tag and master tag information may be...spectrally shaped and power-adjusted...to render them substantially imperceptible.

“modifies the signal sufficiently so that a reduced quality is perceptible” is taught in column 2, lines 51-53 where he teaches that as additional generations of copies are made, the quality or fidelity of the underlying data signal is reduced.

It is noted that Warren does not explicitly use the term “compression” combined with “decompressed” versions as claimed. However, he teaches that his method is meant to work with compressed digital audio streams such as those, which follow the MPEG, Musicam, and Dolby AC-2 and AC-3 formats. It is common knowledge that compressing and decompressing a signal repetitively will inherently cause a reduction in quality. Fukuda is cited in combination to show that there are particular schemes that are well known to cause additional degradation upon

compression or expansion such as removing frequency components (co 20, lines 28-38), reducing sampling rate (col. 20, lines 38-43) or adding noise to various audio components (col. 20, lines 44-67) Therefore, it would have been obvious for a person having ordinary skill in the pertinent art, at the time the invention was made, to modify audio data to degrade the signal as it is compressed and decompressed because Warren explicitly teaches that his copy management system is also designed to work with common compression methods such as those listed above which rely on psychoacoustic masking properties similar to that of Fukuda.

Claims 3-7, 16, 17, 23, 24: “Increasing levels of certain frequency components of the audio signal” is taught by his spread spectrum signals which are spectrally shaped and power-adjusted (col. 2, lines 28-30). The compression formats for digital audio streams noted above all select the number of bits based on psychoacoustic masking thresholds based on frequency band analysis (i.e. – Fourier transform).

Claims 8-10: Selecting a different compression mode is admitted by the applicant as obvious on page 31 where the specification teaches that particular compression methods such as Dolby AC-3 also use Huffman coding for additional compression. However, the wording of this claim actually contradicts the use actual implementation of this technique because the claim requires the invocation of “one compression mode that is different” whereas the combination by Dolby noted above is not at all a selection between different coders but is a combination or series of coding.

Claims 12: The “communications network” is taught by Warren who explicitly teaches that it would have been obvious to use his system in other communication networks (see column 11, lines 30-34).

Claim 13, 18, 27: The use of “a physical storage medium” is taught by Warren’s media in figures 1-4 (see col. 4, lines 26-29).

Claim 14: Minimizing initial perception but increasing the perception for a second compression is suggested by Warren who teaches that his system is designed to cumulatively degrade the quality of the data signal according to the number of generations (abstract) which clearly teaches that initial generation will be less perceptible but that later (2+) will be more significantly degraded.

Claim 21, 24: Altering “timing or phase relationships” is suggested in column 8, lines 35-40 where he teaches that when an audio source includes multiple channels...data may be embedded in two or more different channels at the same or different times.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

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Alexandria, VA 22313-1450

**The Central fax number is 571-273-8300.** Please label INFORMAL” or “DRAFT” communications accordingly.

Mail Stop should be omitted if none is indicated.

Effective 14 January 2005, except correspondence for Maintenance Fees, Deposit Accounts (see 37 CFR 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence delivered by other delivery services (i.e. – Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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Randolph Building  
Alexandria, VA 22314

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (571) 272-7607. The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth, can be reached on (571) 272-7843.

For the Group 2600 receptionist or customer service call (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) between the hours of 6 a.m. and



midnight Monday through Friday EST, or by email at [ebc@uspto.gov](mailto:ebc@uspto.gov). For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

A handwritten signature in black ink, appearing to read "David D. Knepper", written in a cursive style.

David D. Knepper  
Primary Examiner  
Art Unit 2626